

Application No. 09/774,074
Response to 10/01/2004 Action

Attorney's Docket No. 10006308-1

REMARKS

Claims 1-20 are pending. Independent claims 1 and 9 have been amended.

Claims 1-4, 6, 9-12, 14, 17, and 18 stand rejected under 35 U.S.C. § 102(b) for anticipation by U.S. Patent No. 5,991,515 to Fall et al. ("Fall"). Claims 7, 8, 15, 16, 19, and 20 stand rejected under 35 U.S.C. § 103(a) for obviousness over a combination of Fall and U.S. Patent No. 5,243,414 to Dalrymple et al. ("Dalrymple"). Claims 5 and 15 stand rejected for obviousness over a combination of Fall and so-called "prior art disclosure by the applicant", in particular page 4, line 4, of this application. These rejections should be reconsidered and withdrawn because none of Fall, Dalrymple, and the "prior art disclosure" discloses or even suggests all of the features recited in Applicants' claims as originally filed (claims 17-20) or as currently amended (claims 1-18).

Applicants' claim 1 as amended, for example, defines a method for formatting a document that comprises, in pertinent part, specifying a text layer for text in a plurality of the regions, wherein each region of the plurality of the regions corresponds to text having the same color. Applicants' claim 17 as filed defines a method for formatting and compressing information contained within a document that comprises, in pertinent part, specifying a text layer for a body of text having a particular color in the regions. As explained in this application at page 5, line 3 et seq., among other places, the division into multiple regions is based on the colors of bodies of text, which serves to preserve text color information at the same time as it eliminates the need for a separate color layer.

Fall simply does not disclose such operation. As depicted in Fall's Fig. 4d, for example, Fall's "bands" 112 are merely non-overlapping rectangular areas that have no relation to the underlying objects. With respect to Applicants' claim 17, the Action asserted that "Fall teaches . . . specifying a text layer for text in a plurality of the regions", which might be interesting but is certainly not relevant to the claim, which actually recites "specifying a text layer for a body of text having a particular color in the regions" as noted above.

Because Fall fails to disclose all of the elements of claims 1-4, 6, 9-12, 14, 17, and 18, it is respectfully submitted that Fall cannot anticipate those claims.

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The deficiency in Fall that is discussed above is not remedied by either Dalrymple or the "prior art disclosure". For example, Dalrymple merely describes an input device or software "that permit specification by a user, directly or indirectly, of color text, images, or the like". Col. 5, ll. 51-61. This has nothing to do with the subject matter claimed.

Because Fall and Dalrymple, and Fall and the "prior art disclosure" do not describe all of the elements of Applicants' claims, these combinations fail as bases for *prima facie* cases of obviousness against the claims. It is also believed that the cited documents would not have supplied any motivation to combine them as suggested by the Action and that there would have been no reasonable expectation that such complex documents could be successfully combined to yield a working system, which even then would have had to be further modified to obtain the claimed subject matter. In view of the significant differences between the subject matter claimed and the citations, it is unnecessary to discuss these other requirements of a *prima facie* case in detail. Accordingly, it is respectfully requested that the obviousness rejections be reconsidered and withdrawn.

It is believed that this application is in condition for allowance, and an early Notice of same is respectfully solicited. If the Examiner has any questions, the undersigned attorney may be telephoned at the number given below.

Respectfully submitted,



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